



LH 005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Catherine Lin-Hendel

Serial No.: **09/619,255**

Filed: **July 19, 2000**

For: **System and Method for Interactive,
Computer Assisted Personalization
of On-Line Merchandise Purchases**

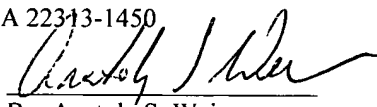
Art Unit: **3625**

Examiner: **Mark A. FADOK**

Final Office Action Mailed On:

October 24, 2005

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING (37 CFR § 1.8)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	
On: <u>1/24/2006</u> Date	 By: Anatoly S. Weiser

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This paper is responsive to the outstanding final Office action mailed on the date shown above (the "Final Office Action"). On page one of the Final Office Action (Summary sheet), the Final Office Action purported to set a two-months shortened statutory period for reply, and on page 13, the Final Office Action set a shortened statutory period of three months for reply. It appears that the proper shortened statutory period is three months, in which case this paper and accompanying papers are timely. If the undersigned attorney is mistaken in this regard, Applicant conditionally petitions for a one month extension of time, and authorization is granted to charge the necessary time extension fee to Deposit Account Number 50-3196. Authorization is also granted to charge Notice of Appeal fee and all other fees necessary to file this paper and accompanying papers to the same Deposit Account. A separate paper authorizing the charges is attached to this paper. Applicant requests review of the final rejection in the above-identified application for the reasons

stated in the Remarks below. Notice of Appeal is being filed with this pre-appeal brief request for review. No amendments are being filed with this request. I am the attorney of record.

REMARKS

Summary of Art Rejections

The Final Office Action rejected claims 1, 3-5, 9, 10, 16, and 20 “under 35 U.S.C. 103(a) as being unpatentable over Danish et al (6,412,012) in view of Official Notice.” Applicant understands this rejection to be based on Danish *et al.*, U.S. Patent Number 6,327,588 (“Danish”). See Applicant’s Reply to Office Action of 3/22/2005, mailed on 7/22/2005, page 10, note 2. The Final Office Action also rejected claims 2, 6-8, 12-15, and 17-19 under 35 U.S.C. 103(a) as being unpatentable over Danish in view of Official Notice and further in view of Weaver, U.S. Patent Number 6,404,426 (“Weaver”). Claim 21 was rejected under the same statute as being unpatentable over Danish in view of Official Notice, Weaver, and Hashimoto *et al.*, U.S. Patent Number 5,729,699 (“Hashimoto”). Applicant respectfully submits that the rejections constitute clear error.

Claim 1 The Final Office Action asserts (page 10, first paragraph) that Danish discloses, in column 3, lines 50-65, using the profile to determine recommendations. In the cited text, Danish teaches a data file representing a family and subfamily of items, and identifying at least one alternative for each item. The subfamily is identified by a guided parametric search. Danish, col. 3, lines 37-51. Danish does not teach that a search is based on a profile of the user.

The Final Office Action argues (at page 9) that a profile of the user means “any information that is saved (even temporarily) from a users session.” Such broad definition has no basis in either the present application or in the English language. The noun “profile” means “a set of data often in graphic form portraying the significant features of something,” “a graph representing the extent to which an individual exhibits traits or abilities as determined by tests or ratings,” or “a concise biographical sketch.” Merriam-Webster Online Dictionary, available online at <http://www.m-w.com/cgi-bin/dictionary>. (Here we ignore the obviously-inapplicable meanings of “profile” relating to outline representation or public exposure.) Therefore, in the present context, “profile” must relate to the user’s significant features or traits, such as preferences. Danish does not teach generating a profile of the user, or using the user’s profile to determine recommendations.

Furthermore, the alternative items associated with each item in Danish are based on neither the user's profile nor any other information about the user. Similarly, Danish defines a family "as a collection of offerings with specific qualifiers and/or attributes," see column 5, lines 48-49. The user of the Danish's system delineates the family of items of interest through a search menu, which may include Alphabetical Search, Picture Search, View Catalog, or Get Part Number Information methods. Danish, col. 5, line 54-61. These methods are further described in Danish, col. 5, line 67 *et seq.* A user's search based on product description (alphabetical, picture, catalog, P/N description) is not the same as using the user's profile to determine recommendations, as recited in claim 1.

At least for these reasons, Danish does not render claim 1 obvious. It was clear error to equate a profile of the user with any information that is saved from a user's session, and to equate using the user's profile to determine recommendations with searching a database in accordance with user-specified product description.

Claim 4 This claim recites means for providing the user with names of a plurality of vendors for the merchandise recommended to the user. In contrast, Danish's system searches through products of a single vendor, AMP Incorporated. See, for example, Figures 1, 31-33, and 35. See also Figures 5, 7-10, and 26-30, which show products and the trade name FASTON®, a trademark of AMP Incorporated. Danish, col. 5, lines 42-45. The Final Office Action argues that mere duplication of the essential working parts of a device involves only routine skill in the art, citing St. Regis Paper Co. v. Bemis Co., Inc., 549 F.2d 833, 193 U.S.P.Q. 8 (7th Cir. 1977). The St. Regis opinion, however, is heavily fact-dependent. Danish's searching through the database of a single known vendor is very different from searching a network to find vendors who supply the merchandize that fits the user's need. In Danish's case, it appears that the user needs to know the name of each vendor or the location of each vendor's website/database before searching. These facts were not present in St. Regis. The Final Office Action neither compares the facts in St. Regis to the facts in this case, nor explains why, based on this comparison, the legal conclusion here should be the same as in St. Regis. Instead, it appears that the Final Office Action relies on St. Regis as establishing a *per se* rule that duplication of parts would have been obvious. But "reliance on *per se*

rules of obviousness is legally incorrect and must cease.” *In re Ochiai*, 71 F.3d 1565, 1572, 37 U.S.P.Q.2d 1127, 1133 (Fed. Cir. 1995).

It was clear error to rely on a *per se* rule of obviousness in rejecting claim 4.

Claim 9 According to claim 9, retrieved data is stored in a local database which is smaller than the at least one database, thereby enabling the user to interact with the system without having to traffic data through a network and thus at a faster speed than would be possible if the user had to traffic data through the network. Danish apparently does not disclose or suggest this additional limitation. Danish’s Figure 25 “is a representation of a server and client configuration and the flow of data therebetween.” Danish, col. 5, lines 6-7. Figure 25 shows FEATURE SCREEN STATUS 127 being transmitted from the SERVER 125 to the CLIENT 126, but does not show a small database being transmitted to the CLIENT 126. Moreover, Danish expressly states that “[a]ll of the program files and data files described in the local embodiment reside on the server 125.” Danish, col. 18, lines 38-39. Danish also includes a description of the operation of the Internet-based embodiment in column 19, lines 1-39. As we argued in the Reply to Office Action of 3/22/2005, mailed on 7/22/2005, pages 13-14, in Danish the data are trafficked through the network for each search iteration, in contrast to the limitation in issue here. Claim 9 requires that storing the retrieved data in the smaller local database enable the user to interact with the system without having to traffic data through a network and thus at a faster speed. As Danish makes clear in column 19, lines 1-39, the system described in that document does not enable its user to interact without trafficking the data.

It was clear error to disregard the recitation in claim 9 of *thereby enabling the user to interact with the system without having to traffic data through a network and thus at a faster speed*.

Claims 2, 12, 13, and 17 The Final Office Action asserts that “[i]t would have been obvious to a person having ordinary skill in the art to include in Danish the virtual modeling capabilities as taught by Weaver, because this type of preview allows the user to become more comfortable with the purchased articles when the transaction is done online (col 1, lines 15-20).” Applicant submits that such combination is unworkable in the context of Danish’s system.

In the preferred embodiment described by Danish, the product family searched is FASTON Receptacles-Uninsulated. Danish, col. 5, lines 42-45. More generally, Danish’s “family of items 1

could be any commercial product or service offering with a common set of features 5 and alternatives 6, associated therewith.” Danish, col. 5, lines 38-40 (underlining added for emphasis). The motivation to supplement Danish with virtual clothes modeling of Weaver does not apply in the context of electrical connectors, which are not modeled in the same sense as clothing. Moreover, the motivation to combine offered by the Office Action does not apply to commercial products, as opposed to clothing intended for personal use.

It was clear error to combine Danish’s electrical connectors with Weaver’s virtual modeling of clothes.

Claim 2 With respect to claim 2, the Final Office Action cites Kraemer, U.S. Patent No. 6, 490,602 (“Kraemer”), at column 5, lines 25-40, as teaching inclusion of links to a database for other types of merchandise in a list of recommendations. Kraemer apparently does not disclose using said intelligence rules to match the merchandise with the accessories and having links to databases for other types of merchandise, as recited in claim 2. While Kraemer speaks of different vendors, we have not identified any teaching in Kraemer of having links to databases for other types of merchandise.

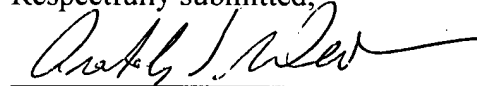
It was clear error to take Official Notice that including links to databases for other types of merchandise in a list of recommendations was well known.

Claim 19 the Office Action asserts that “[i]t was old and well known in the art . . . to be able to retrieve additional items that may not be on a provided list (i.e. adding to a shopping cart).” The issue, however, is not whether it was known to add items to a shopping cart, but whether it was obvious to add matching items to an array of recommendations.

It was clear error to equate a list of recommendations with a shopping cart.

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Respectfully submitted,



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